

REMARKS

Applicant has carefully reviewed the Office Action mailed December 28, 2006 prior to preparing this response. Currently claims 1-16 and 20-44 are pending in the application, wherein claims 1-16 and 20-44 have been rejected. Claims 1, 20, 36 and 39 have been amended with this paper and claim 45 has been added. No new matter has been added with these amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claim Amendments

In view of comments presented in the Office Action regarding possible definitions for the term “contiguous”, occurrences of the term in the claims have been amended to read “in contact with”, thus obviating any perceived ambiguity attributed to the term “contiguous”. Moreover, each of claims 1, 20, 36 and 39 states that a substantial portion of the polymer jacket is in contact with the core wire.

Claim Rejections

Claims 1, 5, 6, 20, 24, 25 and 39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schroepfel et al., U.S. Patent No. 5,957,966. Applicants respectfully traverse this rejection.

Each of claims 1, 20 and 39 states that the polymer jacket is attached to and surrounding a portion of the core wire such that a substantial portion of the polymer jacket is in contact with the core wire. Schroepfel et al. ‘966 at least fails to teach this limitation of the claims. Namely, in the Figures of Schroepfel et al. ‘966, the conductor wire (42) is loosely coiled within the confines of the sleeve (12) and not attached to either segment (28) or segment (30) of the sleeve (12). See Figs. 2, 5, 6, 7 and 8, for example. As shown in the Figures, the conductor wire (42) is spaced away from the sleeve (12) such that a substantial portion of the sleeve (12) is not in contact with the conductor wire (42).

For at least this reason, claims 1, 20 and 39 are believed patentable over Schroepfel et al. ‘966. Claims 5, 6, 24 and 25, which depend from one of claims 1, 20 and 39 and contain additional limitations, are similarly believed patentable over Schroepfel et al. ‘966. Withdrawal of the rejection is respectfully requested.

Claims 1, 36, 37, 39 and 40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Zhou, U.S. Patent Application Publication No. 2002/0183654. Applicants respectfully traverse this rejection.

Each of claims 1, 36 and 39 states that the polymer jacket is attached to and surrounding a portion of the core wire such that a substantial portion of the polymer jacket is in contact with the core wire. Zhou at least fails to teach this limitation of the claims. Namely, as disclosed in Zhou, the first tip member (126) must be spaced away from the second tip member (128) in order to allow deflection of the first tip member (126) prior to engaging the second tip member (128). If a substantial portion of the second tip member (128) was in contact with the elongate member (106), then deflection of the first tip member (126) of the elongate member (106) would be thwarted since the first tip member (126) of the elongate member (106) would be unable to deflect before engaging the second tip member (128).

For at least this reason, claims 1, 36 and 39 are believed patentable over Zhou. Claims 37 and 40, which depend from one of claims 1, 36 and 39 and contain additional limitations, are similarly believed patentable over Zhou. Withdrawal of the rejection is respectfully requested.

Claims 7-16 and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schroepfel et al., U.S. Patent No. 5,957,966, in view of Takahashi, U.S. Patent No. 6,485,458. Applicants respectfully traverse this rejection. Claims 7-16 depend from claim 1, and claims 26-35 depend from claim 20. Claims 1 and 20 are believed patentable over the teachings of Schroepfel et al. '966 for at least the reasons stated above. Takahashi fails to remedy the shortcomings of Schroepfel et al. '966 in order to establish a *prima facie* case of obviousness. Therefore, these claims are additionally believed allowable.

Claims 1-5, 20-24 and 36-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burmeister et al., U.S. Patent No. 5,452,726, in view of Schroepfel et al., U.S. Patent No. 6,024,764. Applicants respectfully traverse this rejection, asserting a *prima facie* case of obviousness has not been established with the cited combination at least because there is no suggestion, motivation or desirability to modify the teachings of Burmeister et al. in view of Schroepfel et al. '764.

Burmeister et al. disclose a guidewire including a core wire and a plastic jacket. Burmeister et al. teach that the core wire may be "selectively formable" into a particular shape and "the shape will be maintained by the wire." Burmeister et al. at column 5, lines 19-23.

Thus, as taught by Burmeister et al., it is the core wire which is more stiff than the surrounding polymer jacket, as it is the core wire which maintains the shape. Thus, the guidewire of Burmeister et al. is able to be selectively formed by a physician to a desired shape by bending the core wire.

Schroeppel et al. '764 disclose a tubular sleeve which may be placed on an implantable tubular device not otherwise having shapeable properties in order to allow a physician "to customize the shape of the tubular device." See Schroepel et al. '764 at Abstract.

One of skill in the art would not be motivated to modify the guidewire of Burmeister et al. with the tubular sleeve of Schroepel et al. as the guidewire of Burmeister et al. already has the ability to be selectively formed by a physician prior to use. Therefore, inclusion of a tubular sleeve to customize the shape of the device would be redundant and thus undesired, as the guidewire of Burmeister et al. is already selectively formable. Therefore, the proposed substitution would be contrary to the understandings and expectations generally known in the art. Thus, one of skill in the art would not find it advantageous to modify the guidewire disclosed in Burmeister et al. in view of the teachings of Schroepel et al. 764.

It is settled law that motivation to combine the teachings of prior art references cannot be taken from Applicants' own disclosure, but must be found in the prior art itself. Applicants respectfully assert that without the benefit of Applicants' disclosure, no motivation to make the proposed modification can be gleaned from the prior art such that one of ordinary skill in the art would make the proposed modification.

Furthermore, even if one were to incorporate of the tubular sleeves as disclosed in Schroepel et al. '764 with the guidewire of Burmeister et al. (which the Applicants do not concede), the tubular sleeves would not be in contact with the metallic core wire as currently claimed. As Schroepel et al. '764 disclose the tubular sleeves being positioned over an otherwise complete implantable tubular device, such incorporation of the sleeves with the guidewire of Burmeister et al. would result in the sleeves being placed on the outer surface of the polymer jacket, not the core wire.

Thus, a *prima facie* case of obviousness has not been established regarding claims 1, 20, 36 and 39. For at least this reason, these claims are believed patentable over the cited references. Claims 2-5, 21-24, 37-38 and 40-44, which depend from one of claims 1, 20, 36 or 39 and

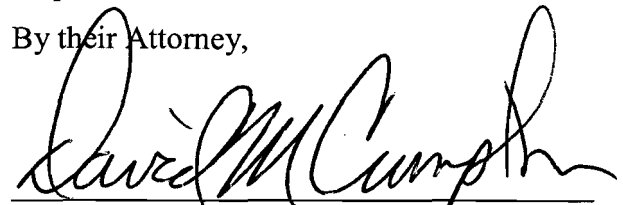
include additional limitations, are also believed patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

Stephen Griffin et al.

By their Attorney,

A handwritten signature in black ink, appearing to read "David M. Crompton", written over a horizontal line.

David M. Crompton, Reg. No. 36,772
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349

Date: 3/19/07